

## Remarks and Comment

### REJECTIONS UNDER 35 U.S.C. §103

#### 1) Examiner fails to make a prima facie case of obviousness

Examiner has not demonstrated all elements of the prima facie case, and therefore Examiner's opinion of obviousness is deficient and Applicant is deserving of a patent. The Federal Circuit endorses this view in writing:

"if the examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent."<sup>1</sup>

To successfully establish a prima facie case of obviousness, Examiner must provide: A) one or more references, B) that were available to the inventor(s), C) and that teach, D) that include some minimal cooperation, E) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Examiner has failed to establish one or more of these elements which necessarily renders Examiner's prima facie case of obviousness defective. These points are addressed herefollowing with specificity.

#### A) References are Required to 'Teach'

##### I) References Do Not Contain Required *Teachings*

The Federal Circuit has made it quite clear in saying:

"[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious."<sup>2</sup>

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<sup>1</sup> *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992)

<sup>2</sup> *In re Wood*, 599 F.2d 1032, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 U.S.P.Q. 30, 32 (C.C.P.A. 1964))

Although Examiner purports to find each of Applicant's explicitly claimed elements in a combination of references, Examiner does not show how those references actually *teach* the combination as required. The presence of each claim element is not enough to render a conclusion of obviousness. Examiner must show how Applicant's invention is actually taught in the reference. In the present case, Examiner's Office Action makes no allegation regarding what is taught – with specificity. As such, Applicant cannot address the question of whether or not the references contain appropriate teachings. It is not to Applicant to prove the references do not teach these thin disk optical coupling elements for wrist watch systems, but rather to the patent office to establish teachings are indeed present in the art.

## II) Cited Teachings are Not *Enabling*

The obviousness standard requires prior art to teach. Accordingly, nonenabling inventions, for example failed experiments or inoperative inventions, are not to be considered prior art<sup>3</sup>. Courts have held that failed experiments are irrelevant as prior art and cannot be used in an obviousness rejection<sup>4</sup>. The Federal Circuit notes in writing:

**"The 'failed' experiment reported in the prosecution history of the Mason patent renders that patent irrelevant as a prior art reference. As stated by Judge Learned Hand, 'another's experiment, imperfect and never perfected will not serve as an anticipation or as part of the prior art, for it has not served to enrich it.'<sup>5</sup>"**

In the present case, even where teachings are described, it has not been shown by the patent office that these teachings are in fact enabling teachings. Applicant hereby asserts that any teaches of the art cannot be

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<sup>3</sup> In re Wilder, 429 F.2d 447, 166 U.S.P.Q. 545, 548 (C.C.P.A. 1970)

<sup>4</sup> Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 225 U.S.P.Q. 26, 33 (Fed. Cir 1985)

<sup>5</sup> Picard v. United Aircraft Corp., 128 F.2d 632, 635, 53 U.S.P.Q. 563, 566 (2d Cir.) *cert. denied*, 317 U.S. 651 (1942)

considered enabling teachings in view of that which is described as his inventions.

**B) Suggestion to Combine or Modify the Reference**

**I) References Must Contain Suggestion to Combine or Modify**

There must be some logical reason apparent from positive concrete evidence of record that justifies a combination of primary and secondary references<sup>6</sup>. It is insufficient to show merely that each separate element of a claimed combination can be found in one or various prior art references<sup>7</sup>.

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination<sup>8</sup>.

Although the ability to combine elements may be within the skill of the art, absent a suggestion in the prior art of the desirability of doing so does not make the combination obvious<sup>9</sup>. Combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination cannot establish obviousness<sup>10</sup>.

**II) References Teach Away**

The position for a finding of a lack of motivation to combine or modify is supported by the prior art which teaches away from Applicant's claimed inventions. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from

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<sup>6</sup> *In re Regel*, 526 F.2d 1399, 1403, 188 U.S.P.Q. 136, 139 (C.C.P.A. 1975); *In re Stemniski*, 444 F.2d 581, 586-587, 170 U.S.P.Q. 343, 348 (C.C.P.A. 1971).

<sup>7</sup> *Canadian Ingersoll-Rand Co. v. Peterson Prod., Inc.*, 223 F.Supp. 803, 139 U.S.P.Q. 61 (N.D. Cal 1963)

<sup>8</sup> *In re Gergen*, 11 U.S.P.Q. 2d 1652, 1653 (C.A.F.C. 1989); *In re Grabiak*, 769 F.2d 729, 732, 226 U.S.P.Q. 870 872 (C.A.F.C. 1985).

<sup>9</sup> *In re Deminski*, 796 F.2d 436, 230 U.S.P.Q. 313 (C.A.F.C. 1986).

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following the path set out in the reference, or would be led in a direction divergent from the path that the Applicant took<sup>11</sup>. Further, a reference teaches away if it suggests the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by Applicant<sup>12</sup>.

### III) Combination Includes Application of Hindsight

Not only must a suggestion or motivation to form the combination exist, but it must have existed before the date of Applicant's invention<sup>13</sup>.

Thus it is incorrect for Examiner to formulate the suggestion or motivation based on current knowledge; Examiner must remove all knowledge accumulated since the date of invention<sup>14</sup>. As stated by the Federal Circuit:

**"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'"**<sup>15</sup>

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<sup>10</sup> Smithkline Diagnostics, Inc., v. Helena Labs. Corp., 859 F.2d 878, 886, 8 U.S.P.Q. 2d 1468, 1475 (C.A.F.C. 1988); *In re Geiger*, 2 U.S.P.Q. 1276, 1278 (C.A.F.C. 1987).

<sup>11</sup> *In re Gurley*, 27 F.3d 551, 31 U.S.P.Q. 2d 1130, 1131 (Fed. Cir. 1994)

<sup>12</sup> *United States v. Adams*, 383 U.S. 39, 52, 148 U.S.P.Q. 479, 484 (1966) ("known disadvantages in old devices which would naturally discourage the search for new inventions may be taken into account in determining obviousness"); *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1550-51, 220 U.S.P.Q. 303, 311 (Fed. Cir. 1983) (the totality of a reference's teachings must be considered), *cert. denied*, 469 U.S. 851 (1984); *In re Sponnoble*, 405 F.2d 578, 587, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1963) (reference teaches away if it leaves the impression that the product would not have the property sought by the applicant)

<sup>13</sup> 35 USC §103 ("...the subject matter as a whole would have been obvious at the time the invention was made")

<sup>14</sup> *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 U.S.P.Q. 2d 1593, 1595-96 (Fed. Cir.) *cert. denied*, 481 U.S. 1052 (1987)

<sup>15</sup> *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q. 2d 1596, 1600 (Fed. Cir. 1988))

It is well settled that Examiner must refrain from use of hindsight when examining the question of obviousness<sup>16</sup>. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time the invention was made<sup>17</sup>. To use the application in suit as a guide through the prior art references, combining the right references in the right way to arrive at the result of the claims, is, therefore, quite improper.

The record compels the conclusion that the Examiner, having carefully considered Applicant's disclosure at length was unable to cast the mind back to the "time the invention was made". The Examiner did not, as the statute requires, view the prior art from the perspective of one skilled in the art and uninformed by Applicant's teachings. Applicant described in detail shortcomings of prior art and the superiority of the present invention in accord with the claims. In deciding the obviousness question, Examiner looked to knowledge taught by Applicant, and then used that knowledge against its teacher.

The test is whether the subject matter of the claimed inventions would have been obvious to one skilled in the art at the time the inventions were made, not what would have been obvious to a trier of fact after reading the application in suit. In the present case, for example, one skilled in the art on 02/17/2004 would not find in the prior art neither a teaching nor suggestion of the claimed inventions.

**C) Combination or Modification Must *Appear* to be Obvious.**

Applicant rejects suggestions prima facie elements are made, i.e. that references: are available; teach; or contain suggestions to combine. However, the following presentation argues against any of Applicant's claims as being obvious.

<sup>16</sup> AIR-vend, Inc. v. Thorne Indus., Inc., 625 F.Supp. 1123, 1136, 229 U.S.P.Q. 505, 515 (D. Minn. 1985)

<sup>17</sup> Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (C.A.F.C. 1985)  
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Although presentation of such argument may appear to endorse the position that cited references are valid, Applicant explicitly rejects such conclusion and hereby states the contrary to be the case.

5 A standard of obviousness is set forth in **Graham v. John Deere Co**<sup>18</sup>. It is a three part test where: 1) the scope and content of the prior art is to be determined; 2) the differences between prior art and Applicant's claims are to be ascertained; and 3) the level of ordinary skill is to be resolved. Against this background, obviousness or nonobviousness of the subject matter is to be determined.

10 That test has not been properly applied by Examiner. Applicant is faced with Examiner's mere assertion "*it would be obvious*". Examiner's Action lacks full analysis of: scope and content of the art; difference or differences of all claimed elements; or any appraisal of level of ordinary skill. Applicant solicits reconsideration and redirection with respect to these rejections having been made without proper basis. Applicant further requests detailed explanation so that an appropriate response and defense can be formulated.

15 That an applicant is entitled a patent is established by the introductory language of 35 U.S.C. §102<sup>19</sup>. While 35 U.S.C. §103 imposes further condition for patentability beyond novelty, such does not have the effect of placing the burden of proving the irrelevancy of prior art upon Applicants<sup>20</sup>. Rather, it is to the Examiner to provide at least an appearance of obviousness; failing that, the rejection must be withdrawn.

20 Examiner sets forth her obviousness analysis in pages 3 – 5, in paragraph 7. In that analysis, we can find that Examiner has failed to make the Graham v. Deere Co. elements.

25 Specifically, Claim 1 sets forth:

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<sup>18</sup> 383 U.S. 1, 15, 148 U.S.P.Q. 459, 466 (1966)

<sup>19</sup> 35 U.S.C. 102: 'A person shall be *entitled* to a patent unless-. [emphasis added].

<sup>20</sup> Color Communications, Inc. v. La Clede Mfg. Co., 7 U.S.P.Q. 1164,  
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"a beam turning element formed in or on said thin-disk"; the element is "arranged to redirect beams incident substantially orthogonal thereon in a radially inward direction towards said waveguide".

5 Examiner does not purport to find such element in neither Bryars et al '267  
nor Cerwin '874. Moreover, the discussion of paragraph 7 appears to be silent  
with regard to this explicitly claimed element. With regard to any beam turning  
element, the scope and content of the prior art has not been determined. Further,  
differences between Applicant's beam turning element and any beam turning  
element of the art has not been ascertained. Examiner was silent with regard to  
10 the structural details of the claimed beam turning element. Also, in this regard,  
Examiner did not resolve any level of ordinary skill. With all of these elements  
still in question, it cannot be said that the test of *Graham v. Deere Co.* has been  
applied in view of Applicant's beam turning element.

15 While Examiner mentions that Cerwin teaches a 'waveguide', Examiner  
does not allege that waveguide is arranged as Applicant instructs. Mere inclusion  
of a waveguide in Cerwin does not obviate the remarkable arrangement of  
Applicant. Examiner writes:

20 "Cerwin also teaches an optical waveguide (44) capable of controlling the transmission  
of light and angle of incidence, grating (see col.4, l 50-52), which is capable of controlling  
illumination."

25 While Cerwin does discuss a waveguide having non-parallel surfaces, or a  
'wedge' system, in no version does Cerwin promote a waveguide to couple light  
radially towards a center. Furthermore, a 'waveguide array' is most certainly not  
part of any Cerwin system. A plurality of wedge shaped waveguide in a radial  
arrangement, as claimed, is not found in Cerwin – and Examiner has seemingly  
ignored this claim limitation.

Similarly here (the waveguide) Examiner does not describe the scope and content of the prior art, Examiner does not point out the difference between waveguides of Cerwin and Applicant. Examiner also fails to resolve the level of ordinary skill as applied to any differences. As to Applicant's explicitly claimed waveguide limitation in Claim 1, Examiner has not performed the required test for obviousness.

There are additional differences between Applicant's Claim 1 and the prior art. All differences must be considered. It is not enough that 'a few', or 'most of' the differences be considered, but rather it is a necessity that all the differences be explicitly identified and analyzed. Applicant seeks revisit with respect to the differences (of all Claims 1 - 20) to which Examiner was silent.

After consideration of the discussion above, if it is now found that Claim 1 is not obvious, i.e. in view of the beam turning element, or the waveguide for instance, then all claims which depend therefrom, without further consideration are also non-obvious and now allowable. That is, Claims 2 – 10 would be non-obvious if Claim 1 is non-obvious for the same reasons argued above.

However, Claim 2 additionally has limitation explicitly set forth but not considered in any Graham v. Deere Co. test for obviousness. Claim 2 sets forth:

"beam turning element is further characterized as a grating formed of a plurality of periodic structures disposed on a thin-disk surface opposite the surface in which the entrance aperture lies"

Examiner fails to consider any scope and content of the art with respect to beam turning elements. Examiner does not make any determination as to the scope of beam turning elements of Bryars or Cerwin. Examiner does not point to any differences between the beam turning elements of Applicant and the cited art despite there being clear and important differences. Examiner does not resolve the level of ordinary skill with regard to beam turning elements. These steps must be considered or the obviousness test cannot said to have been performed.



Claim 3 further sets forth additional limitation not found in Claims 1 or 2.

In particular, Claim 3 recites a:

"grating being cylindrically symmetric blazed type grating formed of a plurality of surface relief repeat structures in a top surface of said thin-disk, each repeat structure forming a concentric circle having a radius different each of the other repeat structures"

Examiner has not found this structure anywhere in the art, does not mention finding any such structure and indeed not exists. Yet, the claim is subject to the same thin 'obviousness reasoning' of paragraph 7. It should be immediately clear that Examiner's obviousness presentation of her paragraph 7 is wholly insufficient to support any analysis under Graham v. Deere. Withdrawal of the rejection is solicited.

The burden is not on Applicant to go claim-by-claim, feature-by-feature, element-by-element in proving distinction from the art. Conversely, it is the burden squarely placed on Examiner to consider all elements of all claims, and further to perform the 3-part test with regard to each. Applicant hereby asserts that Examiner has not properly executed such test in view of any of Applicant's claims 1 – 20. As such, the §103(a) rejections to those claims should now be withdrawn.

**2) Examiner's Rejection(s) are Procedurally Defective**

Examiner has not provided necessary information required by MPEP §706.02(j). Examiner's burden for supporting an obviousness rejection is described as follows:

**"35 USC §103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more others. After indicating that the rejection is under 35 USC §103, there should be set forth in the office action (1) the relevant teachings of the prior art relied upon, ... (2) the difference or differences in the claim over applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation**

**why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made."**

Applicant hereby requests Examiner provide information required in agreement with MPEP and further specify information necessary to support an obviousness type rejection. Reconsideration of the rejection is requested in view of 37 CFR 1.111(b).

Examiner has not made the required showing as to the relevant teachings of the prior art relied upon. Further, Examiner has not indicated the all of the many differences between the art and Applicant's claim elements. Still further, Examiner has not indicated any proposed modifications with regard to the applied citations as required by the MPEP. Examiner has not provided an explanation why such proposed modification would be obvious, but rather, merely declared that it was so.

**3) Examiner Uses Personal Knowledge**

It appears, at least in part, that Examiner uses personal knowledge or judicial notice to support rejections relating to obviousness. Accordingly, Applicant hereby requests an affidavit under 37 CFR §1.107(b) with respect to any and each rejection based upon Examiner's personal knowledge or judicial notice.

Applicant submits this answer and believes it will traverse each and every rejection set forth in the above-identified examination placing the claims in condition for immediate allowance. In accordance, Applicant now supplicates re-examination and a favorable conclusion on the earliest possible occasion should it please his Honorable Commissioner.

Very respectfully submitted,

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Group Art Unit: 3737  
Examiner: LEACH, C.

A handwritten signature in black ink, appearing to read 'Joseph Page', with a long horizontal stroke extending to the right.

Joseph Page  
reg. # 35,311

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